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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/179,002	10/26/98	LOHRAY	V U-011904-5

000140
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HM12/0409

EXAMINER

RAYMOND, R

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

04/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/179,002

Applicant(s)
Lohray et al.

Examiner
Richard L. Raymond

Group Art Unit
1624



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13, 24-34, and 65-86 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-13, 24-34, and 65-86 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The present application has been under suspension. Prosecution on the merits is herein reopened.
2. The Information Disclosure Statement of March 9, 2001 has been considered. The cited WO 97/31907 patent is drawn to compounds where Z is phenylalkylene or $-NR^3-Y-[(C=O) \text{ or } (CH(OH))] -T-R^5$. The compounds of the present application have an $-OR^6$ group at the corresponding position. Patentably distinction is involved.

Improper Markush Rejection

3. Claim 24 is rejected as being an improper Markush claim in the grouping of specific pyrimidine compounds with the elected quinazoline compounds. Note the seventh, eighth and eleventh compounds on page 127. Limitation of the claim to the elected quinazolines will overcome this rejection.

Obviousness-type Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-13, 24-34 and 65-86 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending child Application No. 09/507,371. Although the conflicting claims are not identical, they are not patentably distinct from each other because overlap exists. It appears that the compounds of the child application encompass the present elected compounds.

6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

7. It is again noted that the compounds of EP 903,343, of record, encompass the present compounds. Note that X in the compounds of the patent can be O and W can be the present quinazolinyl ring. While the issue date of the European patent is subsequent to the effective filing date of the present application, any corresponding U.S. application and/or patent would involve interfering subject matter.

8. This action is **not** made final.

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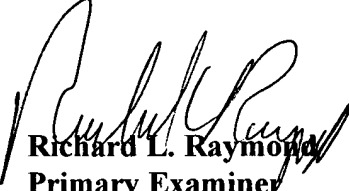
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Raymond whose telephone number is (703) 308-4523. The examiner can normally be reached on weekdays from 9:30 AM to 6:00 PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

rr

April 7, 2001


Richard L. Raymond
Primary Examiner
Art Unit 1624